

**Amendments to the Drawings**

The attached sheet of drawings includes amended Figs. 3a and 3b and replaces original sheet 3 including Figs. 3a and 3b. In both figures, labels have been added pursuant to the Examiner's request.

Attachments: Replacement sheet

**REMARKS**

Claims 1-12 are pending in the application and stand rejected.

**Objections to the drawings**

The drawings are objected to for lacking labels. Applicants hereby submit a replacement sheet with amendments to the figures to overcome these objections.

**Rejection under 35 U.S.C §112**

Claims 8 and 9 stand rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner objects to claims 8 and 9 reciting steps (b) through (d) when no such steps can be found in the antecedent claims. Applicants have amended claims 8 and 9 to remove all references to steps (b) through (d).

**Rejection under 35 U.S.C §102**

Claims 1-12 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,073,142 to Geiger. In particular, the Examiner finds that, with regard to claim 1, Geiger discloses all of the claimed limitations. Applicant has reviewed the reference with care, paying particular attention to the passages cited, and is compelled to respectfully disagree with the Examiner's characterization of this reference. Claim 1 is directed to a method comprising four steps that are performed in a specified sequence. Geiger does not disclose all of these steps, and does not teach performing these steps in the specified sequence.

In particular, the Examiner alleges that Geiger teaches intercepting an e-mail sent by a sender at col. 10, ll. 34-38, presenting the e-mail to the sender in such a way that the sender can amend the e-mail at col. 3, ll. 47-53 and col. 11, ll. 11-25, and in response to a specified triggering event dependent on satisfaction of the sender's criteria, transmitting the e-mail to one

or more recipients at col. 3, ll. 47-53. Applicant disagrees with the Examiner's understanding of the teachings of Geiger, and further traverses the Examiner's rejection for being based upon a disjointed reading of Geiger in an attempt to stitch together various portions of the disclosure into something akin to Applicant's claimed method, with no support or motivation whatsoever in the document itself for attempting such a re-arrangement of its teachings.

For instance, col. 3, ll. 47-53 of Geiger teaches that “[a]s another example, a business rule that returns an e-mail message to its sender may be triggered when the e-mail message or its attachments exceed a certain size, or that are addressed to a particular distribution list, such as "All Employees."” Similarly, col. 11, ll. 11-25 teaches that “During manual review, the gatekeeper evaluates 428 any or all of the messages in the inbox, and may immediately execute an action on the message, including releasing 430 the message, returning 432 the message to its sender (with or without an explanation as to why it was returned and not delivered), deleting 434 the message, copying 436 the message, and gating the message by forwarding 438 it to yet another gatekeeper, or otherwise forwarding 438 the message to another recipient for further handling. In addition, the gatekeeper can edit 440 a message, for example to remove offensive language, delete an attachment, or the like. After editing, the gatekeeper can release 430 the message for further delivery (to the specified recipients or other recipients), or return 432 it to the sender with an explanation of why the message was not delivered.”

There is nothing in either of these two passages specifically cited by the Examiner, or anywhere else in Geiger for that matter, that teaches or alludes to presenting the e-mail to the sender in such a way that the sender can amend the e-mail. All that Geiger teaches is returning an e-mail to the sender if it runs afoul of certain rules, such as maximum size. At best, Geiger teaches that a returned e-mail may include an explanation of why it was returned. However, there is no teaching of allowing the sender to edit the e-mail and the only rational reading of Geiger would lead the skilled person to conclude that if the sender desires to edit the returned e-mail message, the sender would have to manually re-open the message and edit it, because the system of Geiger does not present the returned e-mails in such a way that the sender can amend the e-mail.

Furthermore, the passage alleged by the Examiner to disclose “in response to a specified triggering event dependent on satisfaction of the sender’s criteria, transmitting the e-mail to one or more recipients,” in fact simply teaches that a business rule that returns an e-mail message to its sender may be triggered when the e-mail message or its attachments exceed a certain size, or that are addressed to a particular distribution list. The Examiner appears to be misled by the presence of the word “trigger” in this passage, as there is nothing in the passage nor anywhere else in Geiger that teaches or alludes to waiting for a triggering event dependent on satisfaction of the sender’s criteria, nor of sending the e-mail to the recipients upon occurrence of the triggering event. The specific passage cited by the Examiner discusses a triggering event that is related to a rule enforced by the e-mail server and that has nothing to do with sender transmission criteria, to wit “when the e-mail message or its attachments exceed a certain size, or that are addressed to a particular distribution list.” Furthermore, upon passage of this triggering event, the e-mail is sent back to the sender, not on to the one or more recipients as per Applicant’s claim 1.

In view of the above discussion, Applicant respectfully submits that claim 1 is in fact patentable over Geiger. Should the Examiner disagree, Applicant respectfully requests the Examiner to clearly and specifically point out where Geiger discloses each of the features discussed above, in accordance with 37 C.F.R. 1.104(c)2.

Claims 2-9 depend from claim 1. In view of the above discussion, it is submitted that claim 1 is allowable, and for this reason claims 2-9 are also allowable.

Regarding claims 10-12, the above discussion regarding Geiger is equally relevant to these claims, and therefore, for the reasons advanced above, Applicant respectfully submits that these claims are also patentable over Geiger.

Applicant has amended the claims to bring them closer in line with current U.S. practice, and expressly notes that these amendments were therefore not made for reasons related to patentability.

Regarding the prior art made of record by the Examiner but not relied upon, Applicants believe that this art does not render the pending claims unpatentable.

In view of the above, Applicants submit that the application is now in condition for allowance and respectfully urge the Examiner to pass this case to issue.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 08-2025. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2025.

I hereby certify that this correspondence is being deposited with the United States Post Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

March 31, 2005

(Date of Transmission)

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(Name of Person Transmitting)



(Signature)

3/31/05

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Respectfully submitted,



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Attachments